

SEP 10 2009

Doc Code: AP.PRE.REQ

PTO/SB/33 (07-09)

Approved for use through 07/31/2012. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]</p> <p>on <u>September 10, 2009</u></p> <p>Signature <u>Nick Bromer</u></p> <p>Typed or printed Nick Bromer name _____</p>		Application Number	Filed
		10/568,416	02/14/2006
		First Named Inventor	
		Seiichi Murakami	
Art Unit		Examiner	
4147		John J. Morris	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. 33,478 Registration number _____</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.</p> <p><input type="checkbox"/> *Total of _____ forms are submitted.</p>			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.8. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

SEP 10 2009

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of: **Seeichi Murakami**

Group Art Unit: 4147

Serial No.: 10/568,416

Examiner: John J. Morris

Filed: February 14, 2006

P.T.O. Confirmation No.: 7562

Docket: 060118

Date: September 10, 2009

For: **TRANSPARENT TOUCH PANEL AND
ELECTRONIC APPARATUS****ARGUMENTS with PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Commissioner for Patents
P.O. Box 1450, Alexandria, VA 22313-1450
Sir:

A Notice of Appeal and a Pre-Appeal Brief Request For Review are submitted herewith.

The Applicant's arguments are as follow:

(1-2) Claims 1, 2, 3, 5, 6, and 7 are rejected under 35 U.S.C. §102(b) as being anticipated by Furuhashi et al., US 2002/0000979. This rejection was respectfully traversed.

U-shape. In the Response to Arguments on page 2, the Examiner first states that U-shape is not recited in the claims. However, the feature is recited in claim 8. The Applicant's remarks re claim 8 were germane, regardless of where stated, because claim 8 was not yet rejected. With respect, claim 8 appears not to have been examined.

"Paste." The Examiner asserts that the dabs of conductive paste 8CH and 8DH must be holding something because they are "paste," which the Examiner equates to adhesive. The Examiner writes (page 2, line 13), "paste is to hold things together ... the edges are held together with the paste and without the paste the edges would not be held together." With respect, however, the dictionary, the reference itself, and logic all contradict the Examiner, as follows:

(1) Paragraph 0101 of Furuhashi states, "The upper and lower substrates 1 and 2 are panel-aligned with each other through adhesive materials 8A to 8D." These are disclosed as

Patent Application Serial No. 10/568,416

double-sided tape, etc, in paragraph 0106. Are the pastes “8CH” and “8DH” then *sub-parts* of the adhesives 8C and 8D?

No. Paragraph 0108 states that “conductive paste 8CH, 8DH [are] provided to penetrate the adhesive materials 8C and 8D partially.” A subpart does not “penetrate” the whole. Also, this penetration is illustrated clearly in the middle view of Fig. 2, and more especially the exploded sub-view within a dashed-line circle, which shows a gap between the paste and the adhesive.

(2) The word “paste” does not *only* mean adhesive, and therefore the Examiner’s assertion overreaches. The Random House Dictionary defines *paste* as “any material or preparation in a soft or plastic mass ... dough [for] pie crust ... pasta ... semisoft fruit confections ... food reduced to a smooth soft mass, as for a relish ... a mixture of clay, water, etc. ... glass [for] imitation gems ... a hard smack, blow, or punch.” Of the nine nouns, only one is related to adhesion: “a mixture of flour and water ... causing paper or other materials to adhere.”

According to the dictionary, *only* flour and water constitute an adhesive paste, and the paste 8CH, 8DH of Furuhashi, lacking both flour and water, is excluded from this definition: it evidently comes under “any material or preparation in a soft or plastic mass,” which is *not* stated to be adhesive by the dictionary.

(3) Still further, the paste is not “in direct contact with at least one peripheral edge” as the claim recites. The Examiner asserts (page 2, line 13), “the fact that the paste is in between the two surfaces does not exclude it from holding the edges together.” The Applicant agrees that there is no exclusion, but exclusion is logically immaterial to the rejection. The question as to this rejection is, does it *actually* hold the edges together?

A reference anticipates a feature if it discloses it, not if it is not excluded from disclosing it. If that were the legal standard, then any reference would anticipate any invention.

It is noted that the Examiner states, “The applicant argues that ... conductive paste is not conductive.” Clarification is requested. The Applicant protests against having argued any such logical impossibility.

Patent Application Serial No. 10/568,416

Lead-Out Terminals. The Applicant argued that “Furuhashi’s substrate 1 has no lead-out terminals anywhere near the periphery,” to which the Examiner replied (page 2, line 17), “Furuhashi teaches lead-out terminals in figure 2.” However, only the substrate 2 possesses such terminals; Furuhashi’s upper substrate 1 lacks them. Therefore, the reference does not anticipate the Applicant’s feature: “a plurality of lead-out terminals ... extending to the peripheral edges of the first substrate *and* the second substrate.”

Notch. The Examiner has not clarified the asserted correspondence between the claimed features and the specific elements of the reference, but element 8C is applied against the claimed notched portion of claim 3 (bottom of page 4).

The Examiner asserts (bottom paragraph on page 2) that the Applicant has not argued against the rejection. However, the Applicant argued that “the notch 8c [i.e., 8C] is not formed in a portion of a substrate,” while claim 3 recites “notched portions formed in a portion of the second substrate,” therefore the Applicant’s remark is directly related to patentability. Element 8C of Furuhashi is an adhesive (as mentioned above).

The connection region 10—which is not applied—is not in contact with holding members. Fig. 3 shows a narrow gap between the adhesive 8C and the connection region 10.

(3-5) Claims 4, 8, and 9 are rejected under 35 U.S.C. §103(a) as being obvious over Furuhashi in view of Takashi, JP 200 187237. This rejection was respectfully traversed.

Grooves. The Examiner takes Official Notice of the grooves recited in claim 4. The Examiner was requested to produce an actual reference, as required by the MPEP, but has not done so. Therefore the rejection is, with respect, improper.

Terminals. Like Furuhashi, Takashi does not disclose lead-out terminals extending to the edge of both substrates.

Clips. The clips 13 of the new Takashi reference hold one of the two glass substrates 3, 4 (namely, 4) to a wiring board base 7 which is, apparently, not transparent. Unlike the claimed holding members, they do not have portions “inserted between the transparent first substrate and the second substrate” as the last paragraph of claim 1 recites.

Patent Application Serial No. 10/568,416

In summary, the rejection is respectfully submitted to contain errors and omissions. The examiner's re-consideration is requested.

Respectfully submitted,

KRATZ, QUINTOS & HANSON, LLP



Nick S. Bromer
Attorney for Applicant
Reg. No. 33,478

NSB/lrj
1420 K Street, N.W.
Washington, D.C. 20005
(202) 659-2930

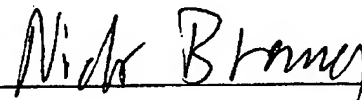
23850

PATENT & TRADEMARK OFFICE

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (571-273-8300) on September 10, 2009.

Nick Bromer (reg. no. 33,478)

Signature



060118 Argument.wpd